

## REMARKS

This Response is submitted in reply to the Office Action dated May 14, 2009. Claims 1, 11, 21 to 23, 27, 31, 33, 35, 44, 47, 52, 58 have been amended for clarity. Claims 36 to 43 stand cancelled. No new matter has been added by these amendments. A Supplemental Information Disclosure Statement is submitted herewith. Please charge Deposit Account No. 02-1818 for all fee due in connection with this Supplemental Information Disclosure Statement and this Response.

The Office Action rejected claims 1 to 35, 44, and 47 to 58 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,190,255 to Thomas et al. ("Thomas").

The Abstract of Thomas discloses:

[a] bonus game for a slot machine operable in a basic mode and a bonus mode. The bonus game is entered upon the occurrence of a special start-bonus game outcome in the basic mode. In the bonus game, a player selects, one at a time, from an array of windows each associated with a bonus game outcome. Credits are awarded based upon which ones of the windows are selected. The bonus game ends upon selection of a window associated with an end-bonus outcome but otherwise continues, allowing the player to make further selections and accumulate further credits until encountering an end-bonus outcome. In one embodiment, a bonus game resource obtained in the basic game may be exercised in the bonus game to affect the bonus game outcome. In one embodiment, for example, where the occurrence of an end-bonus outcome would otherwise end the bonus game, a player having a bonus game resource may exercise the bonus game resource upon encountering an end-bonus outcome to continue playing the bonus game.

Column 5, lines 35 to 62 of Thomas also discloses that:

the possible basic game outcomes include a special symbol combination (e.g., "bonus-resource" outcome) causing the processor to generate a bonus game resource exercisable in the bonus game. The occurrence of "bonus-resource" outcome(s) may also cause the processor to award coin(s) or credit(s) in the basic game. In one embodiment, the processor continues to operate in the basic mode after the occurrence of a bonus-resource outcome. In this embodiment, any number of bonus-resource outcomes may occur through several repetitions of the basic game (causing the processor to generate a corresponding number of bonus game resources) before entering the bonus mode, if at all, upon the occurrence of a start-bonus outcome. The bonus game resource(s) may comprise any item which operates to enhance the excitement and/or winning expectation in the bonus game. In one embodiment, for example, a bonus game resource is usable to override an otherwise undesired

outcome of the bonus game. For example, in a bonus game including one or more "end-bonus" outcome(s) which would otherwise end the bonus game, a bonus game resource, if available, may be used to override the end-bonus outcome and thereby continue play of the bonus game. Another type of bonus game resource might be used as a multiplier (e.g., 2x, 5x, 10x, etc.) of coin(s) or credit(s) awarded in a bonus game. For example, a "5x" resource played in conjunction with a bonus game outcome awarding 5 coins or credits would result in an award of 25 coins or credits.

Amended independent claim 1 is directed to a gaming device including, amongst other elements, a memory device which stores a plurality of instructions, which when executed by the processor, cause the processor to operate with the display device and the input device, for each play of a bonus game, to: (a) select and display at least one of a plurality of different outcomes of a first round, (b) select one of a plurality of different probabilities of providing a winning outcome of a second round, wherein the probability of providing the winning outcome of the second round is: (i) greater than zero, (ii) selected based exclusively on the number of non-selected outcomes of the first round and (iii) selected regardless of which of any of the outcomes of the first round were selected, (c) determine whether to provide a player the winning outcome of the second round, wherein the determination is based on the selected probability of providing the winning outcome of the second round, and (d) display an award based on at least one of the selected outcomes of the first round and any winning outcome of the second round, wherein the award is determined independent of any base game outcome.

The Office Action appears to interpret making a first selection of a window of Thomas as selecting and displaying at least one of a plurality of different outcomes of a first round of the gaming device of independent claim 1. The Office Action also appears to interpret the windows remaining that are each associated with a winning value after the first selection of Thomas as the selection of a probability of providing the winning outcome of the second round, which is based exclusively on the number of non-selected outcomes of the first round of the gaming device of previously presented independent claim 1.

Applicant submits that based on this interpretation, Thomas does not disclose a gaming device that includes for each play of a bonus game, cause the processor to

select one of a plurality of different probabilities of providing a winning outcome of a second round, wherein the probability of providing the winning outcome of the second round is greater than zero. In Thomas, the probability of providing a winning outcome of a second round is not greater than zero for each play of a bonus game. For example, if a 10 window selection game of Thomas includes 5 selections associated with winning values and 5 selections associated with end-bonus outcomes, the player has a 5/10 (or 50%) chance of obtaining a winning outcome for a first selection (i.e., interpreted as a first round of the gaming device of claim 1). If the player selects a winning outcome for the first selection, then the player has a 4/9 (or 44%) chance of obtaining a winning outcome for the second selection (i.e., interpreted as the second round of the gaming device of claim 1). That is, if the player picks a winning outcome with the player's first selection, then 4/9 (or 44%) of the selections remain as possible winning outcomes for the player's second selection. Alternatively, in this example, if the player selects an end-bonus outcome for the first selection of Thomas (i.e., interpreted as a first round of the gaming device of claim 1), the selection game ends. That is, the player is not given a second selection and the player has a 0% chance of obtaining a winning outcome for the second selection. Thus, the probability of providing a winning outcome for the second selection of Thomas is not greater than zero for each play of a bonus game.

Applicant further submits that if the Office Action relies on the bonus resource outcomes of Thomas to avoid the consequences of selecting an end-bonus outcome with the player's first selection, the probability of providing a winning outcome for the second selection of Thomas is still not greater than zero for each play of a bonus game. In Thomas, the player must earn the bonus resource outcomes from a base game. Thomas does not disclose providing a player with a bonus resource outcome for each game played. The probability of providing a winning outcome for the second selection of Thomas is therefore not greater than zero for each play of a bonus game. On the other hand, the gaming device of amended independent claim 1 includes, amongst other elements, for each play of a bonus game, cause a processor to select one of a plurality of different probabilities of providing a winning outcome of a second round, wherein the probability of providing the winning outcome of the second round is greater than zero.

Moreover, if the Office Action interprets Thomas such that a bonus resource outcome is available to a player for each play of the selection game, Applicant submits that such bonus resource outcomes are still not obtained independent of a base game outcome. In Thomas, the player must earn bonus resource outcomes from a base game. That is, if a player obtains a bonus game resource for use in the selection game of Thomas is dependent on outcomes from a base game. On the other hand, the gaming device of amended independent claim 1 includes, amongst other elements, for each play of a bonus game, cause the processor to operate with the display device and the input device to display an award based on at least one of the selected outcomes of the first round and any winning outcome of the second round, wherein the award is determined independent of any base game outcome.

For at least the above reasons, Applicant submits that amended independent claim 1 is patentably distinguished over Thomas and is in condition for allowance.

Applicant submits that claims 2 to 10 depend directly or indirectly from amended independent claim 1 and are also allowable for the reasons given with respect to amended independent claim 1 and because of the additional features recited in these claims.

Amended independent claims 11, 21 to 23, 31, 33, 35, 44, 47, 52, and 58 each include certain elements similar to certain elements of amended independent claim 1. For reasons similar to the reasoning discussed above with respect to amended independent claim 1, amended independent claims 11, 21 to 23, 31, 33, 35, 44, 47, 52, and 58 (and their respective dependent claims) are each patentably distinguished over Thomas and are in condition for allowance.

The Office Action rejected Claims 45, 46, 59, and 60 under 35 U.S.C. §103(a) as being unpatentable over Thomas.

Page 8 of the Office Action stated that Thomas:

is silent to wherein the higher the number of non-provided values of said first round, the higher the probability of obtaining said modifier of said second round, yet applicant's admission for having both embodiments makes obvious to this examiner that the inventor has two choices, have the probability got higher or lower with the increase of chances displayed, making the it a design choice with the limited number of permutations available to the inventor. It would have been obvious to one of ordinary skill

at the time of the invention to decide to go higher, lower or equal when designing the invention.

Applicant respectfully disagrees and submits that, a gaming device that includes:

wherein the higher the number of non-provided values of said first round, the lower the probability of obtaining said modifier of said second round, (claims 45 and 59), and

wherein the higher the number of non-provided values of said first round, the higher the probability of obtaining said modifier of said second round (claims 46 and 60)

is substantially more than a simple design choice. Specifically, the MPEP §2144.04(I) states that a feature that is merely an aesthetic design change does not distinguish from prior art if the claimed features relate to ornamentation and not to function (citing *In re Seid*, 161 F.2d 229 (CCPA 1947)). The MPEP §2144.04(VI)(C) also states that a rearrangement of parts may be an obvious matter of design choice where moving a feature of an invention would not have modified the operation of the device (citing *In re Japikse*, 181 F.2d 1019 (CCPA 1950)). A gaming device including:

wherein the higher the number of non-provided values of said first round, the lower the probability of obtaining said modifier of said second round, (claims 45 and 59), and

wherein the higher the number of non-provided values of said first round, the higher the probability of obtaining said modifier of said second round, (claims 46 and 60)

is neither an aesthetic design change or a rearrangement of parts. Accordingly, the Office Action's conclusions of obvious design choice cannot properly form the basis of this rejection.

Moreover, it would not have been obvious to one of ordinary skill in the art to modify Thomas to result in such gaming devices without reasonably being construed as improper hindsight reconstruction. More specifically, Applicant submits that the Office Action explicitly and improperly works backwards from the claimed invention and adds elements not present in the prior art to form the claimed invention. Obviousness cannot be based on the hindsight combination of components selectively culled from prior art

and the Applicant's own specification to fit the parameters of the claimed invention. MPEP §2142 cautions Examiners that when making a determination of obviousness:

[K]nowledge of applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the "differences," conduct the search and evaluate the "subject matter as a whole" of the invention. The tendency to resort to "hindsight" based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art. (emphasis added).

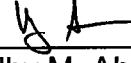
In other words, it is impermissible hindsight to rely on Applicant's own specification to form the basis for a conclusion of obviousness.

In this case, the Office Action explicitly relied on Applicant's own specification to support the Office Action's conclusion of obviousness by referring to features in Applicant's claims as the basis for obviousness. Thus, only with the benefit of hindsight reasoning based on Applicant's own specification is the Office Action picking and choosing different elements from Thomas and the Applicant's specification to recreate the claimed invention to form the basis of these rejections. Such reasoning is improper and thus these rejections are also improper.

Accordingly, for at least these reasons, Applicant submits that claims 45, 46, 59, and 60 are patentably distinguished over Thomas and are in condition for allowance.

An earnest endeavor has been made to place this application in condition for formal allowance and is courteously solicited. If the Examiner has any questions regarding this Response, Applicant respectfully requests that the Examiner contact the undersigned.

Respectfully submitted,  
K & L Gates LLP

BY   
Holby M. Abern  
Reg. No. 47,372  
Customer No. 29159

Dated: July 28, 2009